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09/645,928	08/25/2000	Mark Benson	T2180-906495	4140

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John C Kerins
Miles & Stockbridge PC
1751 Pinnacle Drive
Suite 500
McLean, VA   22102

EXAMINER
BUI, KIM T

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/645,928	BENSON ET AL.
	Examiner	Art Unit
	Kim T. Bui	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 July 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-16</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-16</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

Specification

1.   The abstract of the disclosure is objected to because it should be limited to 150 words. Correction is required. See MPEP § 608.01(b).

.Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A)   "the associated insurance carrier" in claim 1, line 11 lacks clear antecedent basis;

(B)   "the policy carrier" in claim 3, line 6 lacks clear antecedent basis;

(C)   " said receipt and transmission of" in claim 5, lines 1-2 should read " said receipt, update, and transmission of"; "an connection" in claim 5, line 5 should read" a connection";

(D)   "said Internet connection" in claim 8, line 2 lacks clear antecedent basis;

(E)   "said policy subscriber" in claim 9, line 2 lacks clear antecedent basis;

(F)   "the policy issuer", "the agent", and "said field agent" in claim 10, on lines 17, 16, and 19, respectively lack clear antecedent basis;

(G)   "not" in claim 12, line 3 should read "is not";

(H)   "said policy subscriber" in claim 14, line 2 lacks clear antecedent basis;

Dependents claims 2,4-7, 11,13 incorporate the deficiencies of the claims they

depend on and therefor rejected.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1, 2, 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over r Applicant's admitted prior art in the "Background of the Invention " section in view

of Chapman et al (6526386), Mitcham (5537315) and "Insurers Map Electronic Sales

Battle Plan".

(A)   As per claim 1, applicant admits that it is known in the prior art to perform the

steps of:

        a. receiving web pages from an insurance carrier including policy data. See

page 4, lines 22 to page 5, line 15 of Applicant's specification.

        b. updating the web pages by inputting and answering questions by a field agent.

. See page2, lines 20-25, page 3, lines 3-5, lines 19-21, page 4, lines 15-17 of the

Applicant's specification.

        c. transmitting web page back to the carrier. See page 4, lines 17-19 of the

Applicant's specification.

        Applicant also admitted on page 5, lines 7-19 of the Applicant's specification that

it is well known for insurance carrier to provide automatic renewal of policy by preset

underwriting, and for those policies that pass the preset underwriting, quote and policy

are automatically sent to agent at a set time prior to the effective data. Applicant fails to

expressly disclose in the admitted prior art the type of input and the use of a bind web

page. However it is well known in the art to input subscriber's data as well as to

generate a electronic binding or binding online via the Web as evidenced by Chapman

et al, Mitcham and "Insurers Map Electronic Sales Battle Plan".

Chapman et al discloses a computerized system for renewing insurance policy

which allows agents to generate insurance certificates that constitute evidence of

insurance at his/ her terminal without much interaction with the carrier. See col. 1, lines

28-40, col. 2, lines 27-30. Chapman et al teaches the input /edit of subscriber's

information at the agent's terminal and a prior verification of renewal policies at the

carrier before they can be renewed at the agent's terminal. See col. 5, lines 60 to col.6

line 30 and col.6, lines 38-41 of Chapman et al.

Regarding the bind web page, Mitcham teaches a generation of an electronic

bind at a kiosk wherein the user can sign on the screen by pointing device with or

without external underwriting. See col. 1, lines 64-68, col. 3, line 30 to col.4, lines 28,

col. 5, line 1-3, lines 45-52, col. 7, lines 42-48 of Mitcham. Mitcham teaches a

communication link to connect the kiosk operated by the buyer to other computers.

Mitcham fails to teach the application of Internet and the use of terminal

by agent to process insurance policy for buyers. It is, however, well known in the

insurance industry to allow agents connected to insurance carrier via the web to quote

and bind insurance policy on line as evidenced by " Insurer Map Electronic Sales Battle

Plan" on page 3, lines 12-19.

It would have been obvious to one having ordinary skill in the art at the time of

the invention to include subscriber's data as well as to generate a electronic binding or

binding online via the Web with the motivations: of offering a simple and easy way to

buy insurance using the web thereby of reducing demands on the central carrier for cost

effectiveness. (See page 3, lines 18-22 of Insurer Map Electronic Sales Battle Plan); of

facilitating the system operation by automatically generating the binding insurance

agreement. (See col. 5, lines 1-3 of Mitcham); and of conforming to standard practice by

inputting subscriber's information so as to reduce cost and time by reducing interaction

with carrier. (See col. 1, lines 28-40 of Chapman et al).

(B)   As per claim 2, Mitcham and "Insurer Map Electronic Sales Battle Plan" teach the

electronic bind and the binding on line using the web, the bind reflects a legal

agreement between carrier and buyer regarding terms and conditions of the insurance

policy. See col. 5, lines 1-3, col. 4, lines 23-27, col.7, lines 42-48 of Mitcham and page

3, lines 12-16 of "Insurer Map Electronic Sales Battle Plan".

(C)   As per claim 10, applicant admits that it is known in the prior art to:

a. generating web pages representing data of insurance policy at a agent

terminal computer which is readily apparent to include memory, display, CPU, browser

to view the web pages. See page 3, lines 3-29 of Applicant's specification.

b. generating a request from agent to server for insurance web pages. See page

2, lines 9-12 of the Applicant's specification.

c. generating at the web server series of web pages to be transmitted to the

agent at the remote computer including memory for inputting and answering questions

regarding the insurance policy. See col.2, lines 10-25 of the Applicant's specification.

d. receiving, displaying, updating and transmitting back the web pages from the

remote agent computer. See page 2, lines 20-25, page3, lines 22-29, lines 17-21, page

4, lines 15-19 of the Applicant's specification.

Applicant also admitted on page 5, lines 7-19 of the Applicant's specification that

it is well known for insurance carrier to provide automatic renewal of policy by preset

underwriting, and for those policies that pass the preset underwriting, quote and policy

are automatically sent to agent at a set time prior to the effective data. Applicant fails to

expressly disclose in the admitted prior art the decision process at the agent terminal for

issuing web page biding without external underwriting and risk processing. These

features, however, are well known in the art as evidenced by Chapman et al, Mitcham

and "Insurers Map Electronic Sales Battle Plan".

Chapman et al discloses a computerized system for renewing insurance policy

which allow agents to generate insurance certificates that constitute evidence of

insurance at his/ her terminal without much interaction with the carrier. See col. 1, lines

28-40, col. 2, lines 27-30. Chapman et al teaches the input /edit of subscriber's

information at the agent's terminal and a prior verification of renewal policies at the

carrier before they can be renewed at the agent's terminal. See col. 5, lines 60 to col.6

line 30 and col.6, lines 38-41 of Chapman et al.

Regarding the bind web page, Mitcham teaches a generation of an electronic

bind at a kiosk wherein the user can sign on the screen by pointing device with or

without external underwriting. See col. 1, lines 64-68, col. 3, line 30 to col.4, lines 28,

col. 5, line 1-3, lines 45-52, col. 7, lines 42-48. Mitcham teaches a communcation link to

connect the kiosk operated by the buyer to other computers.

Mitcham fails to teach the application of Internet and the use of terminal by

agent to process Insurance policy for buyers. It is,however, well known in the insurance

industry to allow agents to process insurance at terminals connected the carrier via the

web to quote and bind policy on line as evidenced by " Insurer Map Electronic Sales

Battle Plan" on page 3, lines 12-19. It would have been obvious to one having ordinary

skill in the art at the time of the invention to include subscriber's data as well as to

generate a electronic binding or binding online via the Web with the motivations: of

offering a simple and easy way to buy insurance using the web thereby reducing

demands on the central carrier for cost effectiveness. (See page 3, lines 18-22 of

"Insurer Map Electronic Sales Battle Plan"); of facilitating the system operation by

automatically generating the binding insurance agreement. (See col. 5, lines 1-3 of

Mitcham); of conforming to standard practice by inputting subscriber's information and

reducing cost and time so as to reduce interaction with carrier. (See col. 1, lines 28-40

of Chapman et al).

(D)   As per claim 11, it is ready apparent that web pages disclosed in the Applicant's

specification are to be maintained, updated and formatted in suitable manner by

operating software such that useful, accurate and complete web pages can be delivered

to the agent for viewing. See page 2, lines 23-25, page 2, line 26 to page 3, line 2 of the

Applicant's specification.

(E)   As per claim 12, reducing quotes and binding time to minutes and seconds is

possible by the use of on-line binding. See page 2, lines 12-16 of "Insurer Map

Electronic Sales Battle Plan".

(F)   As per claim 13, insurance carrier, renewal policy, and binding are disclosed in

Applicant' admitted prior art, Chapman, Mitcham and "Insurer Map Electronic Sales

Battle Plan" as discussed above in the rejections of claim 10, and incorporated herein.

(G)   As per claim 14, it is well known for a subscriber to act like an agent to buy

Insurance policy directly from the carrier. It is also known that an agent can be a third

party responsible for the subscriber to buy a policy, and that the agent may or may not

be the insurance carrier. This is disclosed in Mitcham and in Chapman et al. See col.4,

lines 9-13 of Mitcham and col. 3, lines 25- 30 of Chapman et al

(H)   As per claim 15, applicant admits that it is known in the prior art to provide the

followings:

        a. network. See page 2, lines 1-9;

        b. policy generator for generating web pages representing insurance policy data.

See page2, lines 10-25.

        c. remote display at agent's computer for displaying received web pages. See

page 3, line 22 to page 4, line 8.

d. the server and remote agent computer with display are connected over the Internet for allowing the agent to view and evaluate insurance policy. See page 2, lines 5-31 of the Applicant's specification.

Applicant also admitted on page 5, lines 7-19 of the Applicant's specification that it is well known for insurance carrier to provide automatic renewal of policy by preset underwriting, and further that, for those policies that pass the preset- underwriting, quote and policy are automatically sent to agent at a set time prior to the effective data. Applicant fails to expressly disclose bind web page. However it is well known in the art to generate an electronic binding or binding online via the Web as evidenced in Chapman et al, Mitcham and "Insurers Map Electronic Sales Battle Plan".

Chapman et al discloses a computerized system for generating certificate at agent's terminal for a renewal insurance policy without much interaction with the carrier. See col. 1, lines 28-40, col. 2, lines 27-50 of Chapman et al.. Chapman teaches a pre-verification process at the carrier before the polices can be renewed at the agent's terminal. See col.6, lines 38-41 of Chapman et al.

Regarding the bind web page, Mitcham teaches a generation of an electronic bind at a kiosk wherein the user can sign on the screen by pointing device with or without external underwriting. See col. 1, lines 64-68, col. 3, line 30 to col.4, lines 28, col. 5, line 1-3, lines 45-52, col. 7, lines 42-48 of Mitcham. Mitcham teaches a communcation link to connect the kiosk operated by the buyer to other computers.

Mitcham fails to teach the application of Internet and the use of terminal by agent to process Insurance policy for buyers. It is, however, well known in the insurance

industry to allow agents to process insurance at terminals connected the carrier via the web and to quote and bind policy on line as evidenced by " Insurer Map Electronic Sales Battle Plan" on page 3, lines 12-19.

It would have been obvious to one having ordinary skill in the art at the time of the invention to include subscriber's data as well as to generate a electronic binding or binding online via the Web with the motivations: of offering a simple and easy way to buy insurance using the web thereby reducing cost and time for insurance processing by reducing interaction with carrier. (See page 3, lines 18-22 of Insurer Map Electronic Sales Battle Plan); of facilitating the system operation by automatically generating the binding insurance agreement (See col. 5, lines 1-3 of Mitcham, and col. 1, lines 28-40 of Chapman et al.

(I)   As per claim 16, insurance carrier, insurance policy, Internet and Web page documents are disclosed in the Applicant's admitted prior art. See page 4, lines 22 to page 5, line 15, page 2, lines 20-25, page3, lines 3-5, lines 19-21, page 4, lines 15-19 of Applicant's specification.

6.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in the "Background of the Invention " section in view of Chapman et al and Mitcham.

(A)   As per claim 3, applicant admits that it is known in the prior art to perform the steps of:

a. providing a field agent with policy data. See page 4, line 22 to page 5, line 15 of Applicant's specification.

    b. providing the field agents screens for inputting and answering questions. See page 2, lines 20-25, page3, lines 3-5, lines 19-21, page 4, lines 15-17 of the Applicant's specification.

    c. answering questions by the agent .See page 2, lines 21-23 of the Applicant's specification.

    Applicant also admitted on page 5, lines 7-19 of the Applicant's specification that it is well known for insurance carrier to provide automatic renewal of policy by preset underwriting, and for those policies that pass the preset underwriting, quote and policy are automatically sent to agent at a set time prior to the effective data. Applicant fails to expressly disclose in the admitted prior art the selected questions to minimize risk and the binding by a decision process undertaken by the agent without external underwriting and rating process. However it is well known in the art to provide decision-processing power at the agent's terminal, to ask question in order to minimize financial risk to the carrier as well as to generate an electronic binding, as evidenced by in Chapman et al and Mitcham.

    Chapman et al discloses a computerized system for renewing insurance policy which provide decision processing power at the agent terminal; the system allows agents to answer for the reason to renew the policy, to generate insurance certificate constitutes evidence of insurance without much interaction with a carrier who can conduct a pre-verification process on the policies before their arrival at the agent's terminal. See col. 1, lines 28-40, col. 2, lines 27-30, col. 2, lines 59-65, col. 6, lines 38-41, lines 64-66 of Chapman et al.

Regarding the binding decision process, Mitcham teaches the questions presented to buyers to protect carrier for issuing unfavorable policy and the generation of an electronic bind at a kiosk wherein the user can sign on the screen by pointing device with or without external underwriting. See col. 1, lines 64-68, col. 3, line 30 to col.4, line 28, col. 5, line 1-3, lines 45-52, col. 7, lines 42-52 of Mitcham.

It would have been obvious to one having ordinary skill in the art at the time of the invention to include decision processing power at the agent's terminal, question to minimize financial risk to the carrier as well as an electronic binding without external underwriting disclosed by Chapman et al and Mitcham with the motivation of reducing risk by questioning the buyers and reducing demands on the central carrier for cost effectiveness. (See col. 5, lines 1-3 of Mitcham and col.1, lines 28-40 of Chapman et al).

7.   Claims 4-6, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in the "Background of the Invention " section in view of Chapman et al and Mitcham as applied to claim 3 above, and further in view of" Insurer Map Electronic Sales Battle Plan".

(A)   As per claims 4-6,8 the steps for receiving, updating and transmitting of sequence of web pages to the agents, for processing insurance on line including answering questions via Internet connection to an Insurance company Web server computer, and for issuing an certificate and/or binding are disclosed in the Applicant's admitted prior art, Chapman et al and Mitcham. See the rejection of claim 3.The references fails to teach on-line binding via web pages through the Internet to reduce the time for issuing policy to minutes. This is disclosed by "Insurer Map Electronic

Sales Battle Plan". See page 3, lines 12-16 of "Insurer Map Electronic Sales Battle Plan".

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate on line binding with the motivation of conforming to the standard Internet technology in business application. (See page 3, lines 1-38, of "Insurer Map Electronic Sales Battle Plan").

(B)   As per claim 9, it is well known for a subscriber to act like an agent to buy Insurance policy directly from the carrier. It is also known that agent can be a third party responsible for the subscriber to buy a policy, and that the agent may or may not be the insurance carrier. This is disclosed in Mitcham and in Chapman et al. See col.4, lines 9-13 of Mitcham and col. 3, lines 25- 30 of Chapman et al.

8.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in the "Background of the Invention " section in view of Chapman et al, Mitcham and " Insurer Map Electronic Sales Battle Plan" as applied to claim 5 above, and further in view of "On Lines Sales Taking Off".

(A)   As per claim 7, it is well known to use the Internet not only for buying insurance but also other products. See col. 4, lines 28-31 of Mitcham. Furthermore " On Line Sales Taking Off" teaches the use of Internet for worker compensation program. See page 2, lines 8-9 of "On Line Sales Taking Off". It would have been obvious to one having ordinary skill in the art to include worker compensation program or any type of contract disclosed by "On Line Sales Taking Off" and Mitcham with the motivation of

expanding the application of the system for various user. (See col.4, lines 28-31 of

Mitcham).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. "Computerized insurance premium quote request and policy

issuance system"(4831526)', "Apparatus for contracts against catastrophic loss"

(5202827); "Design grid for insurance computer system" (5523942); " System for

processing insurance application" (5809478); " On line sales taking of" by "Journal of

Commerce", pages1-3, " Insurers close to Netting customers" by "Journal of commerce"

, pages 1-3.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874.

The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-

305-7687 for regular communications and 703-305-7687 for After Final

communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

KTB
April 7, 2003

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600